

### **REMARKS**

The Office Action dated October 18, 2007, and the patents relied on therein have been carefully reviewed, and in view of the above changes and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

Claims 1-9, 11, 13-20, 23, 27-61 and 63-72 are pending. Claims 9, 11, 13, 16-20, 23, 40 and 54 stand allowed. Claims 1-3, 27-29, 33, 36, 38, 39, 41-43, 47, 50, 52, 53, 55-61, 63, 67, 69 and 71 stand rejected. Claims 4-8, 15, 30-32, 34, 35, 37, 44-46, 48, 49, 51, 64-66, 70 and 72 stand objected to.

This Amendment amends claims 15, 23, 41 and 60.

### **Amendments To The Claims**

Assignee has amended claims 15, 23, 41 and 60 to improve their respective forms in accordance with U.S. patent law. Assignee respectfully submits that the amendments are directed to formal matters and do not narrow the scope of the amended claims. Therefore, no prosecution-history estoppel results from the amendments.

### **The Objection To Claims 1, 5 and 6**

Claims 1-8, 15, 55, 57, 60 and 64-72 stand objected to for various informalities identified by the Examiner.

In particular, claims 1-8, 55, 60 and 64-72 stand objected because the Examiner raises an issue with respect to the phrase "adapted to" as used in claims 1-8, 55, 60 and 64-72. Assignee respectfully traverses this objection. Examiner cites no law, rule, or other legal authority as a basis for the objection, but only cites MPEP § 2106, which is stated to be a guideline. (See MPEP § 2106, Introduction.) Furthermore, queries of the publicly-accessible online United States Patent and Trademark Office (USPTO) Patent Full-Text and Image Database (1976 to present) performed on February 7, 2007, return a total count of 473,638 issued patents with the phrase "adapted to" in the claims (Query: ACLM/"adapted to"). Of these, 343 have an issue date of February 6, 2007 (Query: ACLM/"adapted to" AND ISD/20070206). Thus, Assignee respectfully submits that the Examiner's objection appears to be contrary to the current practice of the USPTO of issuing patents with claims containing the phrase "adapted to." Consequently,

Assignee respectfully requests Examiner to cite a law, rule, and/or other legal authority providing a basis for the objection, or to otherwise kindly withdraw this objection.

Claim 15 stands objected to because the dependency of claim 15 is based on a canceled claim. Assignee has amended claim 15 so that the dependency of claim 15 is now based on claim 9. Consequently, Assignee respectfully requests that the Examiner withdraw this objection.

Claim 57 stands objected to because the Examiner raises an issue with respect to the phrase "capable of" as used in claim 57. Assignee respectfully traverses this objection. Examiner cites no law, rule, or other legal authority as a basis for the objection. Furthermore, queries of the publicly-accessible online USPTO Patent Full-Text and Image Database (1976 to present) performed on March 15, 2006 return a total count of 224,689 issued patents with the phrase "capable of" in the claims (Query: ACLM/"capable of"). Of these, 217 have an issue date of February 6, 2007, (Query: ACLM/"capable of" AND ISD/20070206). Thus, Assignee respectfully submits that the Examiner's objection appears to be contrary to the current practice of the USPTO of issuing patents with claims containing the phrase "capable of." Consequently, Assignee respectfully requests Examiner to cite a law, rule, and/or other legal authority providing a basis for the objection, or to otherwise kindly withdraw the objection.

Claim 60 stands objected to for various additional informalities. Assignee has amended claim 60 to address the various additional informalities. Consequently, Assignee respectfully requests that the Examiner withdraw this objection.

#### **The Rejection Under 35 U.S.C. § 103(a) Over Allan In View of Agarwal**

Claims 1-3, 27-29, 33, 36, 38, 41-43, 47, 50 and 52 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Allan et al. (Allan), U.S. Patent No. 5,946,313, in view of Agarwal et al. (Agarwal), U.S. Patent Application Publication No. 2004/0179486 A1.

Assignee respectfully traverses this rejection. Assignee respectfully submits that the subject matter according to any of claims 1-3, 27-29, 33, 36, 38, 41-43, 47, 50 and 52 is patentable over Allan in view of Agarwal. Assignee respectfully submits that the applied patents are not properly combinable to form a basis for rejection of these claims. Further, the method, apparatus and system resulting from the proffered combination are not the claimed subject matter.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” See, also, MPEP §§ 706.02(j) and 2143.

Regarding the first basic criterion for establishing a *prima facie* case of obviousness, contrary to the Examiner’s statement, there simply is no suggestion in either Allan or Agarwal “to modify Allan to select a compression method from a plurality of selectable compression methods as taught by Agarwal in order to meet various performance specifications of the system [0118].” The Examiner admits that Allan provides no such disclosure or suggestion. (See Office Action dated October 18, 2006, page 3, line 17, through page 4, line 1.) Consequently, such a suggestion for modifying Allan must necessarily be provided by Agarwal. Agarwal, however, discloses nothing regarding a plurality of selectable compression methods. While the Examiner cites paragraph [0118] of Agarwal for support for the Examiner’s assertion, paragraph [0118] of Agarwal merely discloses that “[t]he VC Id field would either be the size of the entire VC field in the frame relay packet or could be the size specified in the header compression parameters.” (See Agarwal, paragraph [0118], lines 2-5.) Thus, paragraph [0118] of Agarwal discloses that the VC Id field could be compressed or, by implication, uncompressed. Accordingly, Assignee respectfully submits that paragraph [0118] is plainly silent regarding a plurality of selectable compression methods.

Moreover, Assignee notes that Agarwal makes reference to the concept of compression in paragraphs [0116]-[0118], [0120]-[0122], [0128], [0136], [0137], [0146] and Table 1. Each reference to the concept of compression refers only to a field or data as being compressed or, by

implication, uncompressed. Thus, Assignee respectfully submits that the Examiner's characterization of Agarwal as disclosing a plurality of selectable compression methods is without basis. As such, Assignee respectfully submits that Agarwal cannot suggest that Allan be modified "to select a compression method from a plurality of selectable compression methods" as urged by the Examiner.

Thus, Assignee respectfully submits that the proffered combination of Allan and Agarwal is formed by impermissible hindsight because neither Allan nor Agarwal suggest the proffered combination.

Regarding the third basis criterion for establishing a *prima facie* case of obviousness, even if the proffered combination of Allan and Agarwal is formed, the resulting method, apparatus and system are not the subject matter according to any of claims 1-3, 27-29, 33, 36, 38, 41-43, 47, 50 and 52.

Regarding claim 1, Assignee respectfully submits that neither Allan nor Agarwal disclose or suggest the claimed network connection provisioning module to grant or reject requests for a communication channel connection which is adapted to select a compression method from a plurality of selectable compression methods upon a grant of a connection, at least one of which includes mapping ATM cell addressing bits into MAC packet addressing fields. Allan does not disclose or suggest the claimed network connection provisioning module as admitted by the Examiner. (See Office Action dated October 18, 2006, page 3, line 17, through page 4, line 1.) Regarding Agarwal, as demonstrated above, Agarwal only discloses the concept of a field or data being compressed or, by implication, uncompressed. Mere reference to the concept of compression does not disclose or suggest a plurality of selectable compression methods. At least for that reason, it follows that Agarwal does not disclose the claimed network connection provisioning module.

Thus, claim 1 is allowable over Allan in view of Agarwal. It follows that claims 2 and 3, which each incorporate the limitations of claim 1, are each allowable for at least the same reasons that claim 1 is considered allowable.

Assignee respectfully submits that claim 2 is allowable over Allan in view of Agarwal for the additional reason that neither Allan nor Agarwal disclose or suggest that for at least one of the selectable compression methods, the MAC reassembly module is further adapted to include payload data of a plurality of ATM cells having a common destination in the payload of the

outgoing MAC data packet and to remove ATM header addressing data from the payload of the outgoing MAC data packet. As demonstrated above, neither Allan nor Agarwal disclose or suggest the claimed plurality of selectable compression methods. Consequently, neither Allan nor Agarwal can disclose or suggest the subject matter of claim 2.

Assignee respectfully submits that claim 3 is allowable over Allan in view of Agarwal for the additional reason that neither Allan nor Agarwal disclose or suggest that for at least one of the selectable compression methods the MAC reassembly module is further adapted to include payload data of a plurality of ATM cells sharing a common destination in the payload of the outgoing MAC data packet and to remove ATM header data from the payload of the outgoing MAC data packet. As shown above, neither Allan nor Agarwal disclose or suggest the claimed plurality of selectable compression methods. Consequently, neither Allan nor Agarwal can disclose or suggest the subject matter of claim 3.

Regarding claim 27, Assignee respectfully submits that neither Allan nor Agarwal disclose or suggest a method comprising selecting a compression process from among a plurality of compression processes. Neither Allan nor Agarwal disclose or suggest the claimed plurality of compression processes. Accordingly, neither Allan nor Agarwal can disclose or suggest selecting a compression process from a plurality of compression processes.

Thus, claim 27 is allowable over Allan in view of Agarwal. It follows that claims 28, 29, 33, 36 and 38, which each incorporate the limitations of claim 27, are allowable over Allan in view of Agarwal for at least the same reasons that claim 27 is considered allowable.

Regarding claim 41, Assignee respectfully submits that neither Allan nor Agarwal disclose or suggest the claimed means for selecting a compression process from among a plurality of compression processes. Neither Allan nor Agarwal disclose or suggest a plurality of compression processes. Consequently, neither Allan nor Agarwal can disclose or suggest the claimed means for selecting a compression process from a plurality of compression processes.

Thus, claim 41 is allowable over Allan in view of Agarwal. It follows that claims 42, 43, 47, 50 and 52, which each incorporate the limitations of claim 41, are allowable over Allan in view of Agarwal for at least the same reasons that claim 41 is considered allowable.

Assignee respectfully submits that it is only by impermissible hindsight that the Examiner is able to reject claims 1-3, 27-29, 33, 36, 38, 41-43, 47, 50 and 52 based on the proffered combination. Neither of the applied patents provides a proper suggestion for combination, and

even if they did, the method, apparatus and system resulting from the proffered combination are simply not the claimed subject matter. It is only by the Assignee's disclosure that the Examiner can attempt to select particular features of Allan and Agarwal to attempt to make the rejection.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection and allow claims 1-3, 27-29, 33, 36, 38, 41-43, 47, 50 and 52.

**The Rejection Under 35 U.S.C. § 103(a) Over Kokudo  
In View of Allan And Further In View Of Agarwal**

Claims 39, 53, 55-61, 63, 67, 69 and 71 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kokudo, U.S. Patent No. 5,978,361, in view of Allan, and further in view of Agarwal.

Assignee respectfully traverses this rejection. Regarding claims 39 and 53, Assignee respectfully submits that Kokudo does not cure the deficiencies of Allan in view of Agarwal with respect to claims 27 and 41, the respective base claims of claims 39 and 53. Assignee respectfully submits that the Examiner's proffered motivation for combining Kokudo, Allan and Agarwal does not cure the deficiencies identified above regarding the lack of a proper suggestion for combining Allan and Agarwal with respect to claims 27 and 41. Moreover, Kokudo does not disclose or suggest a plurality of compression processes. In fact, the word "compression" does not appear in Kokudo. Thus, claims 39 and 53 are allowable over Kokudo in view of Allan, and further in view of Agarwal.

Regarding claim 55, Assignee respectfully submits that none of Kokudo, Allan and Agarwal discloses or suggests the claimed plurality of compression processes, as demonstrated above.

Thus, claim 55 is allowable over Kokudo in view of Allan, and further in view of Agarwal. It follows that claims 56-61, 63, 67, 69 and 71, which each incorporate the limitations of claim 55, are each allowable over Kokudo in view of Allan, and further in view of Agarwal for at least the same reasons that claim 55 is considered allowable.

Consequently, Assignee respectfully requests that the Examiner withdraw this rejection and allow 39, 53, 55-61, 63, 67, 69 and 71.

**Allowable Subject Matter**

Assignee wishes to acknowledge and thank the Examiner for allowing claims 9, 11, 13, 16-20, 23, 40 and 54, and for indicating that claims 4-8, 15, 30-32, 34, 35, 37, 44-46, 48, 49, 51, 64-66, 70 and 72 contain allowable subject matter.

Assignee notes that additional patentable distinctions between Allan, Agarwal and Kokudo and the rejected claims exist; however, the foregoing is believed sufficient to address the Examiner's rejections. Moreover, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, Assignee respectfully submits that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

**CONCLUSION**

In view of the above amendments and arguments, it is urged that the present application is now in condition for allowance. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

A general authorization under 37 C.F.R. § 1.25(b), second sentence, is hereby given to credit or debit Deposit Account No. 50-3703 for the instant filing and for any other fees during the pendency of this application under 37 C.F.R. §§ 1.16, 1.17 and 1.18.

It is requested that this application be passed to issue with claims 1-9, 11, 13-20, 23, 27-61 and 63-72.

Respectfully submitted,  
Berkeley Law and Technology Group, L.L.P.

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